

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of:	Carpenter	
SERIAL NO.:	10/040,129	
FILING DATE:	January 2, 2002	Group Art Unit: 2178
FOR:	Method For Dynamically Generating Reference Identifiers In Structured Information	Examiner: Huynh, C.

Mail Stop: AF
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Response to Final Office Action

Dear Sir:

In response to the Final Office Action dated February 27, 2006, Applicant respectfully requests reconsideration of the outstanding rejection(s) of the claims in view of the amendments and remarks that follow.

REMARKS

In the Office Action dated February 27, 2006, claims 1-21 were presented for examination. Claims 1-21 were rejected under 35 U.S.C. §103(a) as being unpatentable over *Jang et al.*, “An Effective Mechanism for Index Update in Structured Documents”, ACM 1999, pages 383-390, in view of *Shin et al.*, “Bus: An Effective Indexing and Retrieval Scheme in Structured Documents”, ACM 1998, pages 235-243, and *Parupudi et al.*, U.S. Patent Publication No. 2005/0080902.

Applicant wishes to thank the Examiner for the careful and thorough review and action on the merits in this application.

The remarks pertaining to *Jang et al.* publication in the prior communications are hereby incorporated by reference.

Shin et al. is an index and query evaluation scheme for structured documents. *Shin et al.* is a static system for processing a document to gather statistical information. The *Parupudi et al.* publication pertains to a hierarchical tree structure with one or more generations of node in the tree. “Each entity or node has a unique identifier and a URL that is associated with the tree on which the node occurs.” Paragraph 83. “To establish prima facie obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art.” *In re Royka*, 490 F.2d 981, 180 USPQ 580 (CCPA 1974). There is no teaching in either *Shin et al.* or *Parupudi et al.* for encoding an attribute in a node identifier as a URL and inserting the URL in an HTML document.

Furthermore, it is accepted that for a rejection under 35 U.S.C. §103(a) to stand, there must be a suggestion or motivation in the references themselves to modify the reference or combine the teachings. See MPEP §2143. “The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, not in

applicant's disclosure". MPEP §2143, citing *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991). As noted by the Examiner, *Jang et al.* fails to teach "generating said identifier includes adding a relevant attribute of an encountered element in said data structure to an HTML document indicating a depth of said element in said data structure, including encoding said attribute as a URL, and inserting said URL in said HTML document." See Office Action dated February 27, 2006, page 4. The Examiner has brought in the *Shin et al.* publication to support the element of "adding a relevant attribute of an encountered element in said data structure to an HTML document indicating a depth of said element in said data structure", as claimed by Applicant, even though *Shin et al.* fails to teach the process of "encoding the attribute as a URL, and inserting said URL in the HTML document." See Office Action dated February 27, 2006, page 4. The Examiner has brought in the *Parupudi et al.* publication to support the element of "encoding said attribute as a URL, and inserting said URL in the HTML document", as claimed by Applicant and not taught in either *Jang et al.* or *Shin et al.* See Office Action dated February 27, 2006, page 4.

Even if it may be ascertained that *Parupudi et al.* teaches the elements of encoding the attribute and inserting the encoded URL in the HTML document, Applicant contends that there is no motivation in the prior art references for combining *Jang et al.*, *Shin et al.*, and *Parupudi et al.* Rather, the motivation for such a combinations stems from the language in Applicant's claims. Clearly, *Jang et al.* is the primary reference and *Shin et al.* and *Parupudi et al.* are the secondary references being applied by the Examiner. *Jang et al.* teaches statically preprocessing a document for search and retrieval and generating a statistical analysis result in response to a query. As such, *Jang et al.* does not provide adding a relevant attribute of an encountered element to an HTML document with a depth indicator, and encoding the attribute as a URL. There is no teaching or suggestion in *Jang et al.* to modify their invention for these elements, as the invention of *Jang et al.* focuses on statistical analysis and not generating a reference identifier in the form of a URL and inserting the URL into the HTML document. To modify the teaching of *Jang et al.* for generating the reference identifier as a URL and inserting the URL into the HTML document as claimed by Applicant would go against the teaching of *Jang et al.*

Applicants' invention focuses on a dynamic principal of generating a reference identifier, whereas *Jang et al.* teaches a static principle.

If the proposed modification or combination of the prior art would change the principle of operation of the prior art invention being modified, then the teachings of the references are not sufficient to render the claims *prima facie* obvious. *In re Ratti*, 270 F.2d 810, 123 USPQ 349 (CCPA 1959) (Claims were directed to an oil seal comprising a bore engaging portion with outwardly biased resilient spring fingers inserted in a resilient sealing member. The primary reference relied upon in a rejection based on a combination of references disclosed an oil seal wherein the bore engaging portion was reinforced by a cylindrical sheet metal casing. Patentee taught the device required rigidity for operation, whereas the claimed invention required resiliency. The court reversed the rejection holding the "suggested combination of references would require a substantial reconstruction and redesign of the elements shown in [the primary reference] as well as a change in the basic principle under which the [primary reference] construction was designed to operate." 270 F.2d at 813, 123 USPQ at 352.).

MPEP §2143.01. Similarly, the suggested combination of *Jang et al.* with *Shin et al.* and *Parupudi et al.* would require a substantial reconstruction and redesign of the computer implemented instructions in *Jang et al.* for generating a reference identifier in a manner not envisioned or contemplated by *Jang et al.* Accordingly, it is Applicant's position that there is no motivation present in *Jang et al.* to be modified in the manner as claimed by Applicant.

It is clear that the Examiner is taking the elements of Applicant's pending claims and combining them in an improper manner. "It is impermissible to use the claimed invention as an instructions manual or 'template' to piece together the teachings of the prior art so that the claimed invention is rendered obvious." *In re Fritch*, 972 F.2d 1260, 1266, 23 USPQ 2d 1780 (Fed. Cir. 1992), citing *In re Gorman*, 933 F.2d 982, 987 (Fed. Cir. 1991). Yet that is the very process that the Examiner has attempted to undertake. Most patents may be considered combination patents in which different elements are combined from prior art to achieve a new and useful apparatus and/or method. Although Applicant's invention may appear to combine elements found in different prior art disclosures, the motivation to combine the references must be in the prior art not in Applicant's pending claims. There is no motivation in the prior art to

combine the references, since such a combination would go against the teaching of *Jang et al.*

It is well settled that each statement of obviousness for the purpose of combining each of the numerous references of record must be found and suggested in the references themselves and not only in the fertile mind of the Examiner. The conclusionary statements of the Examiner must be based upon specific evidence, suggestions and findings in the references of record relied upon by the Examiner in the rejection of the claimed subject matter. It is respectfully submitted that the record before us lacks any valid reasons to combine the references in the manner done so by the Examiner and contains unsupported reasoning suggested by the Examiner. The Examiner has not established a prima facie case of obviousness with respect to the aforesaid set of claims, there being no motivation to combine the references other than that disclosed in the Applicants' specification. "The best defense against the subtle but powerful attraction of a hindsight-based obviousness analysis is rigorous application of the requirement for a showing of the teaching or motivation to combine prior art references". *In re Dembiczak*, 175 F.3d 994, 999, 50 USPQ2d 1614, 1617 (Fed. Cir. 1999). It is respectfully suggested that this rejection which contains neither teachings nor motivation to combine the references is without merit and must be withdrawn. Accordingly, Applicant respectfully contends that the combination of *Jang et al.*, *Shin et al.*, and *Parupudi et al.* does not meet the standard set by the CAFC's interpretation of 35 U.S.C. §103(a), and respectfully requests removal of the rejection of claims 1-21 under 35 U.S.C. §103(a).

Applicant believes that a full and complete reply has been made to the outstanding Office Action and, as such, the present application is in condition for allowance. Accordingly, Applicant requests that the Examiner indicate allowability of claims 1-21, and that the application pass to issue. If the Examiner believes, for any reason, that personal communication will expedite prosecution of the application, the Examiner is hereby invited to telephone the undersigned at the number provided.

In light of the foregoing amendments and remarks, all of the claims now presented are in

condition for allowance, and Applicant respectfully requests that the outstanding rejections be withdrawn and this application be passed to issue.

Respectfully submitted,

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